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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,969	10/31/2005	Pierre Lebot	272252US6PCT	1729
22850 7590 12/28/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MACARTHUR, VICTOR L	
			ART UNIT 3679	PAPER NUMBER
			NOTIFICATION DATE 12/28/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/534,969

**Applicant(s)**

LEBOT ET AL.

**Examiner**

Victor MacArthur

**Art Unit**

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Preamble-Intended Use*

The preamble of claim 37 recites functional intended use limitations that are not taken in combination with the positively recited structure as follows:

- In lines 1-5 of the preamble of claim 37, it appears that the applicant does not intend to positively claim “for being positioned in a glass plate to allow, in cooperation with a connecting element, the glass plate to be mounted on a support, wherein the insert is positionable in a hole of said glass plate”. For purposes of examination the examiner has considered the claims without combination. “(T)he recitation of a new intended use for an old product does not make a claim to that old product patentable”, In re Schreiber, 44 USPQ2d1429 (Fed. Cir. 1997). Accordingly, the prior art meets the applicant’s claimed intended use merely by being capable of such intended usage regardless of whether or not such capability is expressly disclosed (i.e., wherein capability is inherent to the disclosed structure). If the applicant wishes to positively recite the above intended use phraseology then the limitation “for” (line 1 of claim 1) should be replaced with positive terminology. Otherwise, it is well established that patentability of a device is based on the structural recitations thereof and not how such structure is intended to be used. The claims are drawn solely to “An insert” and it is that “insert” structure for which patentability is to be determined.

### ***Claim Objections***

Claims 37-54 are objected to because of the following informalities:

- Claims 37-54 refer to the intended use phraseology noted in the “Preamble-Intended Use” section above in a positive manner. All such references to a mere intended use must be functional in nature (i.e., “operable to”, “shaped for”, “configured for”, etc.) in the interest of claim clarity. Note that positive reference to an intended use limitation renders the claims unclear as to what is being positively claimed and what is mere intended use.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. Take for instance the following examples:

- Claim 37 positively recites that the insert has “retaining walls of a curved profile so as to be self-locking in the hole” (lines 4-6 of claim 37). Since the preamble sets

forth “the hole” as mere intended use, it is unclear how this limitation positively limits the claim.

- Numerous dependent claims, e.g., claims 38-40, raise the question of whether the combination or subcombination is being claimed. In particular, claim 37 merely referenced the hole inferentially and in the context of intended use while claims 38-40 now seek to positively include the hole.
- Claim 45 is incomplete because no structure has been recited to support the functional recitation of self-locking. Further, how does claim 45 further limit claim 37? Note that claim 37 already sets forth a reference to self-locking in the hole at line 5.
- It is unclear if the term “A glass plate” (line 1 of claim 47) is meant to set forth a plate separate from the plate previously set forth in claim 37 or meant to refer to an additional plate.
- Claim 47 is an improper dependent claim because it fails to include all of the limitations of the claim from which it depends. In particular, claim 37 is drawn solely to an insert while claim 47 is drawn solely to a glass plate. Thus, claim 47 fails to include and further limit the insert of claim 37.
- It is unclear how the insert is considered to constitute a part of the glass plate when it was first non-positively recited as an element, separate from the plate, that is intended for use with the plate. Compare claim 48 to claim 47.
- Claim 51 purportedly sets forth a “mounted assembly or assembly to be mounted”. However, no element other than the glass plate has been recited. Since, as set forth,

the assembly” is merely one glass plate, it is unclear how claim 51 further defines the glass plate of claim 47.

- Claim 53 is indefinite because it is not clear which element, the plate or the heating element, is configured to be provided with the recited features.
- Claim 54 positively recites a process for making a plate that is merely intended to be used with an insert. However, claim 54 depends from claim 37 which recites an insert that is merely intended to be used with a plate. Accordingly it is unclear what, if any, elements are meant to be positively claimed in claim 54. Further, no actual process steps have been set forth. The steps of a process should be set forth as action steps, e.g., “machining...”, etc.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner’s best understanding of the claim scope. The applicant is strongly urged to amend the entirety of the claims (not only the examples listed above) to conform to current U.S. practice.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (U.S. Patent 5,106,250).

Claim 37. Fischer discloses (figs.1a-7) an insert (7) made of a deformable (deformation described in col.3, ll.10-60) material said insert having walls (left and right walls of 7 which are curved at top) of a curved profile and the insert comprising at least one removable component made of a deformable material. Furthermore, since the prior art product structure is substantially identical to the claimed structure (in that it is a deformable insert), the following functions and properties are presumed to be inherent, and the applicant has the burden of submitting evidence to show otherwise in accordance with MPEP §2112.01:

- The prior art insert is fully capable of performing the intended use limitation of "for being positioned in a glass plate to allow, in cooperation with a connecting element, the glass plate to be mounted on a support" (since the prior art insert is configured to have long narrow dimensions capable of such function).
- The prior art insert is positionable (but not necessarily positioned) in a hole of a glass plate. Note that no specific hole dimensions are claimed.
- The prior art retaining walls of a curved profile are fully capable of performing the intended use of being for "self-locking in a hole made in one face of a glass plate" (in that it is deformable to do so).

Claim 38. Fischer discloses the insert as claimed in claim 37, wherein the prior art insert is fully capable of performing the intended use limitation of for being positioned in a glass plate having a hole bounded by a side wall of concave profile (since the prior art insert is configured to have long narrow dimensions capable of such function).

Claim 39. Fischer discloses the insert as claimed in claim 37, wherein the prior art insert is fully capable of performing the intended use limitation of for being positioned in a glass plate having a hole that is a blind hole or a through-hole (since the prior art insert is configured to have long narrow dimensions capable of such function).

Claim 40. Fischer discloses the insert as claimed in claim 37, wherein the prior art insert is fully capable of performing the intended use limitation of for being positioned in a glass plate having a hole that has a circular or oblong cross section (since the prior art insert is configured to have long narrow dimensions capable of such function).

Claim 37 and 41-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Studer (U.S. Patent 6,146,383).

Claim 37. Studer discloses (figs.5, 10 and 18) an insert (10) made of a deformable material (metal as denoted by cross-hatching) said insert having walls of a curved profile and the insert comprising at least one removable component made of a deformable material.

Furthermore, since the prior art product structure is substantially identical to the claimed structure (as detailed above), the following functions and properties are presumed to be inherent, and the applicant has the burden of submitting evidence to show otherwise in accordance with MPEP §2112.01:

- The prior art insert is fully capable of performing the intended use limitation of "for being positioned in a glass plate to allow, in cooperation with a connecting element, the glass plate to be mounted on a support" (since the prior art insert is configured to have long narrow dimensions capable of such function).



- The prior art insert is **positionable** (but not necessarily positioned) in a hole of a glass plate
- The prior art retaining walls of a curved profile are fully capable of performing the intended use of being for “self-locking in a hole made in one face of a glass plate”.

Claim 41. Studer discloses the insert as claimed in claim 37, said insert comprising a cup-shaped element (10 is cup-shaped in as much as applicant’s element 8 is) having radial slots (12) forward in a side wall thereof, thus forming petals (petals between 12),

- The prior art element is fully capable of performing the intended use of for being positioned in a corresponding hole in a glass plate (in that it is configured with an outer dimension that is fully capable of such function).
- The prior art petals are bendable elastically or plastically inward to allow the element to be fitted into a corresponding hole in a glass plate (in that they is configured to be flexible and thus fully capable of such function).
- The prior art internal surface of the sidewall of the cup-shaped element is configured to cooperate with the element for connecting a glass plate to a support (in that it is configured with an outer dimension fully capable of such function).

Claim 42. Studer discloses the insert as claimed in claim 41, wherein the cup-shaped element is of circular shape (in horizontal cross-section).

Claim 43. Studer discloses the insert as claimed in claim 41, wherein the cup-shaped element includes three to five slots (12).

Claim 44. Studer discloses the insert as claimed in claim 39, wherein the element has a curved bottom or a curved pierced bottom (bottom of 10).

Claim 45. Studer discloses the insert as claimed in claim 37, wherein:

- The prior art insert is fully capable of performing the intended use of being for cooperation with a connecting element.
- The prior art insert is configured for self-locking within a hole (in that the insert is configured with an outer dimension fully capable of such function).

Claim 46. Studer discloses the insert as claimed in claim 37, wherein:

- The prior art insert sidewall is fully capable of performing the intended use of being for insertion into a hole with a wetting agent for improving surface appearance interposed at an interface there between.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

At the outset, note that the examiner's Official Notice statement that "it is extremely well known in the art to take a non-heat treated plate, machine a hole therein, and then carry out a heat treatment on the plate, for the purpose of increasing the strength of the plate" (see rejection of claim 54 in the previous Office Action mailed 9/7/2007) is now taken to be admitted prior art because applicant has failed to adequately traverse the examiner's assertion of Official Notice. Note that applicant's arguments filed 10/5/2007 amount to a general allegation that the claims

define a patentable invention without any reference to the examiner's assertion of Official Notice much less specifically pointing out why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241.

Claims 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (U.S. Patent 5,106,250).

Claim 47. Fischer discloses a plate (1), made of a brittle material of the glass type (i.e., in that it is refractory as indicated by its cross hatching, see 35 USC 112 2<sup>nd</sup> rejection above), including on at least one of its surfaces a hole (4). Fischer does not expressly state that the plate is glass. However, It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from glass over any other material. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the prior art plate to be glass since the limitation has no criticality, glass is a notoriously old and well-known material and it is well-within the level of skill to utilize known features of the art for the purpose for which they are known.. "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than

promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

- The prior art hole is configured to receive at least one insert as defined in claim 37 (in that it has a cavity fully capable of such function).

Claim 48. Fischer discloses the plate as claimed in claim 47, equipped with at least one insert (7).

Claim 49. Fischer discloses the glass type plate as claimed in claim 48, wherein each insert comprises a connecting element (9).

- The prior art connecting element is configured to cooperate with a support (in that it has threads that are fully capable of such function).

Claim 50. Fischer discloses the plate as claimed in claim 47, but does not expressly state that the plate comprises toughened, tempered, annealed, or mechanically reinforced glass. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from a non-toughened, non-tempered, non-annealed, or non mechanically reinforced materials over a toughened, tempered, annealed or reinforced glass. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a toughened, tempered, annealed or mechanically reinforced glass for the Fischer panel since the limitation has no criticality and one of ordinary skill would have found it readily desirable to provide a glass

greater mechanical strength properties. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Claim 51. Fischer discloses a mounted assembly (assembly of figs.1a-7) or assembly to be mounted, comprising at least one plate as defined in claim 47.

Claim 52. Fischer discloses the assembly as claimed in claim 51, including a wall cladding element (27), an interior furnishing, a partition, or a piece of furniture.

Claim 53. Fischer discloses a heating element comprising a plate as defined in claim 47.

- The prior art plate is configured to be provided with at least one of conducting elements (such as metal element 27 which is inherently a conductor of electricity and heat), screen-printed elements, and with current leads.

Claim 54. Fischer discloses a plate (1) made of a brittle material of the glass type that has a hole (4) at a place of fastening points each hole having a shape and an insert of complementary shape being placed in the hole. Fischer does not expressly state what process was used to make the plate itself. The examiner takes official notice that it is extremely well known in the art to take a non-heat treated plate, machine a hole therein, and then carry out a heat treatment on the plate, for the purpose of increasing the strength of the plate. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to make the Fischer plate by a process including the steps of machining a hole in a non-heat treated plate and then heat treating the plate for the purpose of increasing the strength of the plate.

- The prior art plate is configured to be mounted on a support to constitute a mounted assembly.
- The prior art hole shape is fully capable of performing the intended use of being for to allow an insert as defined in claim 37 to be introduced and retained.

### ***Response to Arguments***

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Regarding claim 37, the applicant argues that the Fischer insert is not positionable in a glass plate. This is not persuasive. MPEP 2112.01 clearly states that the prior art product structure is substantially identical to the claimed structure (in that it is a deformable insert), the following functions and properties are presumed to be inherent, and the applicant has the burden of submitting evidence to show otherwise. The Fischer insert structure is identical to the applicant's claimed insert structure in that it has retaining walls of a curved profile and comprises at least one removable component made of a deformable material, as is detailed in the rejection above. Applicant has failed to point out any claimed structure lacking in Fischer, nor any physical attribute that would prevent the Fischer insert from performing the function of being positioned in a hole in a glass plate, etc.; much less present actual evidence supporting such a claim. Inspection of MPEP 2112.01 should make it immediately clear that the fact that Fischer does not expressly describe such function is irrelevant to the question of whether or not the Fischer structure is inherently capable of performing such function. Further regarding claim 37, note that the "glass panel" is not recited as claimed structure but rather as an intended use that the

Fischer insert is fully capable of being used with to be positionable therein, as detailed in the rejections above. Again, after reviewing MPEP 2112.01, it should be very clear that Fischer's lack of an express description of the claimed function and/or intended use says nothing about whether or not Fischer insert is inherently capable of such function and/or intended use.

Applicant's arguments that the Studer metal structure is incapable of insertion into a hole in a glass plate is not persuasive in accordance with MPEP 2112.01 for the same reasons as detailed with regard to Fischer above. Also note that direct contact is not claimed and not necessary for meeting the limitation of insertion.

Applicant argues that Studer does not disclose deformable petals. This is not persuasive. Deformability is an inherent characteristic of the Studer disclosed metal petals are clearly present in element (10) between (12). See especially figure 18.

It is noted that only the rejection of claim 37 was argued with any degree of particularity and as such all claims stand or fall with the patentability of claim 37. Note 37 <sup>CFR</sup>~~DFR~~ 1.111(b).  
DPS

### *Conclusion*

Applicant's amendment (i.e., the newly added limitation "glass plate" in line 1 of claim 47, replacing "glass type") necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

  
VLM  
December 13, 2007



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